

Appl. No. 09/643,621  
Amdt. Dated January 13, 2004  
Reply to Office action of October 22, 2003  
Attorney Docket No. P11889-US1  
EUS/J/P/04-1004

### **REMARKS/ARGUMENTS**

#### **1.) Amendments**

The Applicants have amended Claims 1 and 13 to more particularly point out and distinctly claim the subject matter regarded as the invention. Claims 1-24 remain pending in the application. Favorable reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

#### **2.) Claim Rejections – 35 U.S.C. §102(e)**

The Examiner rejected Claims 1-4, 6-8, 13-16 and 18-20 as being anticipated by United States Patent No. 5,557,658, issued to Gregorek *et al.* (Gregorek). The Applicants traverse the rejections.

Claim 1 recites:

1. A method of controlling communications with at least two calling party devices by a user of a called party device, said method comprising the steps of:  
establishing a first call link between said called party device and a first calling party device;  
receiving a call request to said called party device from a second calling party device;  
placing said first call link on hold;  
accepting said call request from said second calling party device to establish a second call link between said called party device and said second calling party device;  
causing, in response to the selective activation by said user of said called party device, a message to be transmitted to said first calling party device while said called party device is in communication with said second calling party device, whereby said user of said called party device can communicate information to a user of said first calling party device without interrupting communications with a user of said second calling party device.  
(emphasis added)

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The Applicants' invention is characterized by a user of a called party device causing the sending of a message to a first calling party device while the called party device is in communications with a second calling party device. It should be noted that the preamble of claim 1, prior to amendment, stated that the method of controlling communications was "by a user of a called party device." (emphasis added) This aspect of the Applicants' invention has been emphasized by adding language to the step of causing a message to be transmitted that the message is transmitted in response to the selective activation by the user of the called party device.

Gregorek discloses a call processing system which can transmit a generally continuous pre-recorded announcement to a telephony device that has been placed on hold. Unlike the Applicants' invention, however, the transmission of the pre-recorded announcement is under the control of a switch 22 or attached network signaling system (ANSS) 23, rather than the user of a called party device. The Examiner fails to point to any teaching in Gregorek where a user of a called party device causes the sending of a message to a first calling party device while the called party device is in communications with a second calling party device. Therefore, Gregorek fails to anticipate claim 1.

Independent claim 13 recites limitations analogous to those of claim 1 and, therefore, Gregorek also fails to anticipate that claim. Furthermore, whereas claims 2-4 and 6-8 are dependent from claim 1 and claims 14-16 and 18-20 are dependent from claim 13, and include the limitations thereof, those claims are also not anticipated by Gregorek. The Applicants, therefore, respectfully request that the Examiner withdraw the rejection of claims 1-4, 6-8, 13-16 and 18-20 as being anticipated by Gregorek.

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### 3.) Claim Rejections – 35 U.S.C. §103(a)

The Examiner rejected Claims 5 and 17 as being unpatentable over Gregorek in view of Rogers, *et al.* (US 5,946,386); Claims 9, 10, 21 and 22 as being unpatentable over Gregorek in view of Bull, *et al.* (US 6,498,841); Claims 11 and 23 as being unpatentable over Gregorek in view of Tatchell, *et al.* (US 6,160,877); and Claims 12 and 24 as being unpatentable over Gregorek in view of Tatchell and Zhakov, *et al.* (US Pub. No. 2003/0021264). The Applicants traverse the rejections.

As noted above, Gregorek fails to anticipate independent claims 1 and 13. The teachings of Rogers, Bull, Tatchell and Zhakov fail to cure the deficiencies of Gregorek. Specifically, neither Rogers, Bull, Tatchell or Zhakov disclose a method or apparatus that allows a user of a called party device to cause the sending of a message to a first calling party device while the called party device is in communications with a second calling party device. Accordingly, claims 1 and 13 are not obvious in view of those references, either individually or in combination. Whereas claims 5, 9-12 are dependent from claim 1 and claims 17 and 21-24 are dependent from claim 13, and include the limitations thereof, those claims are also not obvious in view of Gregorek in view of Rogers, Bull, Tatchell or Zhakov, either alone or in combination. The Applicants, therefore, respectfully request that the Examiner withdraw the rejection of claims 5, 9-12, 17 and 21-24 as being obvious over Gregorek in view of Rogers, Bull, Tatchell or Zhakov.

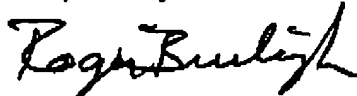
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### CONCLUSION

In view of the foregoing amendments and remarks, the Applicants believe all of the claims currently pending in the Application to be in a condition for allowance. The Applicants, therefore, respectfully request that the Examiner withdraw all rejections and issue a Notice of Allowance for Claims 1-24.

The Applicants request a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,



Roger S. Burleigh  
Registration No. 40,542  
Ericsson Patent Counsel

Ericsson Inc.  
6300 Legacy Drive  
M/S EVW 2-C-2  
Plano, TX 75024  
Phone: 972-583-5799  
Fax: 972-583-7864  
roger.burleigh@ericsson.com